



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	INVENTOR'S ADDRESS	INVENTOR'S CITY
09/900,708	07/06/2001	Karl D. Voss		

DELTA GEN, INC.
1003 Hamilton Avenue
Menlo Park, CA 94025

EXAMINER

QIAN, CHINESE

ART IN.	PAPER NO.
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DATE MAILED: 8/20/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Application No.

Applicant(s)

09/900.708

ALLEN, KENNETH C.

Office Action Summary

Examiner

Art Unit

Celine Qian

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be filed later than SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory period will be deemed to have been filed.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to that matter is closed in accordance with the practice under *Ex parte Quayle*, 155 O.G. 1162 (1946).

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in the International PCT application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application):
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Page # _____
- 5) ☐ Notice of Informal Patent Application (PTO-156)
- 6) ☐ Other _____

DETAILED ACTION

Claims 1-34 are pending in the application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10 and 17-28, drawn to a targeting construct, a method of making said targeting construct, a cell comprising a disruption in a intestinal alkaline phosphate gene, a intestinal alkaline phosphate gene knockout non-human animal and a method of making said non-human animal, classified in class 536, subclass 230.1, class 435, subclass 91.41, class 800, subclass 13 and 21.
- II. Claims 11 and 30, drawn to a method of using a transgenic animal for identifying an agent that modulates intestinal alkaline phosphate gene expression, classified in class 800, subclass 3.
- III. Claims 12, 29 and 31, drawn to a method of using a transgenic animal for identifying an agent that modulates intestinal alkaline phosphatase function, classified in class 800, subclass 3.
- IV. Claim 13, drawn to a method of using a cell disrupted of intestinal alkaline phosphatase gene for identifying an agent that modulates intestinal alkaline phosphatase gene expression, classified in class 435, subclass 320.
- V. Claims 14, 32 and 33, drawn to a method of using a cell disrupted of intestinal alkaline phosphatase gene for identifying an agent that modulates intestinal alkaline phosphatase gene function, classified in class 435, subclass 320.

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VI. Claims 16 and 34, drawn to an agent that modulates intestinal alkaline phosphate gene expression, classified in class 800, subclass 3.

VII. Claims 16 and 34, drawn to an agent that modulates intestinal alkaline phosphate gene function, classified in class 800, subclass 3.

Claim 15 is generic to groups IV and V and will be examined in so far as it reads on the elected subject matter.

The inventions are distinct, each from the other for the following reasons:

The inventions of Groups I, VI and VII are patentably distinct because the inventions are drawn to materially distinct compositions. The transgenic animal of Group I, the agents that modulates the expression of intestinal alkaline phosphatase of Group VI, and the agents that modulates the function of intestinal alkaline phosphatase of Group VII are chemically, biologically and physically distinct from each other. A search of the subject matter of one group would not be co-extensive with a search of the other group and hence would be burdensome. Each group is capable of supporting a separate patent. Therefore, the inventions of Group I, VI and VII are patentably distinct.

The inventions of Groups II-V are patentably distinct because the inventions are drawn to methods that require different starting material and modes of operation. Each method requires different steps. A search of one method would not be co-extensive with a search of the other methods and would be burdensome. Therefore, the inventions of Groups II-V are patentably distinct.

Inventions I and II, III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the invention of Group I can be used in either in the method of Group II or Group III. Therefore, the inventions of Group I-III are patentably distinct from each other.

Inventions II, IV and VI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the products of Group VI can be made by the method of either Group II or Group IV. Therefore, the inventions of Groups II, IV and VI are patentably distinct from each other.

Inventions III, V and VII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product of Group VII can be made from the method of either Group III or Group V. Therefore, the inventions of Groups III, V and VII are patentably distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. A search of the subject matter of one group would

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not be co-extensive with a search of the other group and hence would be burdensome. Each group is capable of supporting a separate patent.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celine X Qian whose telephone number is 703-306-0283. The examiner can normally be reached on 9:00-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel can be reached on 703-305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Celine Qian, Ph.D.
May 13, 2002

DAVID GUZO
PRIMARY EXAMINER
